

ESTTA Tracking number: **ESTTA696302**

Filing date: **09/16/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Toho Co., Ltd.
Granted to Date of previous extension	09/30/2015
Address	2029 Century Park East, Suite 433 Los Angeles, CA 90067 UNITED STATES
Attorney information	Joan Kupersmith Larkin Seyfarth Shaw LLP 2029 Century Park East, 35th Floor Los Angeles, CA 90067 UNITED STATES jlarkin@seyfarth.com

Applicant Information

Application No	86494256	Publication date	06/02/2015
Opposition Filing Date	09/16/2015	Opposition Period Ends	09/30/2015
Applicant	Gordon, Nick 131 Washington Avenue Brooklyn, NY 11205 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Coffee; Coffee and coffee substitutes

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1163122	Application Date	05/30/1979
Registration Date	07/28/1981	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 041. First use: First Use: 1956/00/00 First Use In Commerce: 1956/00/00 Entertainment Services in the Nature of a Continuing Motion Picture Film Series		
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U.S. Registration No.	1858403	Application Date	10/13/1992
Registration Date	10/18/1994	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1956/00/00 First Use In Commerce: 1956/00/00 cinematographic and motion picture films featuring entertainment; [pre-recorded video tapes and cassettes featuring entertainment] Class 028. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 toys and games; namely, video [and computer] game programs; [video and computer game software;] electronic game programs; [video and computer game cartridges;] [discs and tapes;] vinyl toy figures; [friction-powered action toys;] plastic inert figures; plastic action figures; [bubble blowing toys;] [inflatable toy figures;] [and inflatable bop bags]		

U.S. Registration No.	1161858	Application Date	05/30/1979
Registration Date	07/21/1981	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1977/05/01 First Use In Commerce: 1977/05/01 Comic Books [and Coloring Sets Consisting Primarily of Black and White Poster with Color Markers]		

U.S. Registration No.	2211328	Application Date	05/17/1994
Registration Date	12/15/1998	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1987/08/00 First Use In Commerce: 1987/08/00 [PAPER BAGS; PAPER BANNERS;] COMIC BOOKS, [COLORING AND CHILDREN'S EDUCATIONAL PICTURE BOOKS; CALENDARS; TRADING CARDS;] GREETING [, NOTE AND BLANK] CARDS [; PEN AND PENCIL CASES; BOOK COVERS; CRAYONS; DECALS; PAPER NAPKINS; PEN AND PENCIL HOLDERS; RUBBER STAMPS; PENS AND PENCILS; ERASERS; NOTEBOOKS; PAPER PARTYHATS; POSTERS; WRAPPING PAPER; NOTE PADS; SERIES OF FICTION BOOKS FOR ENTERTAINMENT AND AMUSEMENT; FICTION MAGAZINES FOR ENTERTAINMENT AND AMUSEMENT] Class 025. First use: First Use: 1994/12/00 First Use In Commerce: 1994/12/00		


	CLOTHING, NAMELY, [HATS;] SWEAT SHIRTS; [GYM SHORTS; MAS-QUERADE AND HALLOWEEN COSTUMES;] T-SHIRTS; [KNIT SHIRTS; PA-JAMAS; SLEEPWEAR; RAINCOATS; RAINWEAR; FOOTWEAR; HEADWEAR; NECKWEAR; HOSIERY AND SOCKS; PANTS AND SLACKS; SHORTS;] SHIRTS; AND TOPS [; PLAYSUITS; COATS; BRIEFS; UNDERPANTS; AND BOXER SHORTS]
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U.S. Registration No.	2360489	Application Date	10/15/1996
Registration Date	06/20/2000	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark	<p style="text-align: center;">GODZILLA</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1998/05/20 First Use In Commerce: 1998/05/20 [non-electric doorbells; metal clotheshooks; boards containing metal clothes hooks; metal key chains; and metal key fobs]</p> <p>Class 014. First use: First Use: 1998/05/20 First Use In Commerce: 1998/05/20 [watches and clocks; clocks incorporating radios; and lapel pins in the natureof jewelry]</p> <p>Class 016. First use: First Use: 1998/05/06 First Use In Commerce: 1998/05/06 [pre-printed paper stickers and pre-printed sticker collector albums; party game books; chalk boards; magnetic boards;pencil-top ornaments; paper table cloths; invitation cards; paper name badges; door and yard signs made of paper; con-fetti; non-Halloween paper loot bags; paper gift bags; blow outs, namely, paper toys that unfurl when blown into and cellophane loot bags; party meal box and centerpieces made of paper; clinger and printed crepe paper; blank and printed themebooks; stationery-type portfolios; binders; study kits comprised primarily of plastic pouch, pencil, ruler and eraser; blank and printed assignment books; scribble drawing and writing tablets; construction paper; ABC writing and art tab-lets; memo pads; doodle pads; art pads; paper sign-in sheets; crayon-by-number kitscomprised primarily of crayons and pictures for coloring; rub and color line drawing sets comprised primarily of crayons, paper and plastic panels with raised images used to create and color drawings; stamp and roller sets comprised primarily of stamps and rollers made of rubberand plastic; temporary paper and removable tatoos; lap boards for reading and writing; light up desks comprised primarily of battery-operated desks that glow, art sheets and colored pencils for drawing and tracing; flicker rulers, namely, drawing rulers with image of character on backside that appears to move as imagechanges; water-filled plastic placemats; and vinyl placemats]</p> <p>Class 018. First use: First Use: 1998/05/20 First Use In Commerce: 1998/05/20 [backpacks; knap sacks; luggage; carry-on bags; shoulder bags; handbags; clutch bags; rucksacks; canvas carry on bags;school bags; book bags; pocket-books; purses; fanny packs; waist packs; beach tote bags; all-purpose sport bags; athletic bags; duffel bags; golf bags; gym bags; tote bags; mesh, leather and textile shopping bags; wallets; beach umbrellas; and key cases]</p> <p>Class 020. First use: First Use: 1998/05/20 First Use In Commerce: 1998/05/20</p>		

	<p>[beach chairs; drinking straws with play motion; non-metal clothes hooks; boards containing non-metal clothes hooks; window shades; throw pillows; non-metal key chains and key fobs; and desks]</p> <p>Class 021. First use: First Use: 1998/05/20 First Use In Commerce: 1998/05/20</p> <p>[paper cups and paper plates; thermal insulated containers and thermal insulated vinyl bags for holding food or beverages; sports bottles with molded character heads and printed sports bottles with or without sound making capabilities sold empty; squeeze sports bottles; batterypowered toothbrushes and battery powered toothbrushes with voice emitting capabilities sold with and without stands; battery powered toothbrush stands; bathroom organizers, namely, plastic shelves with compartments for storing toiletries; plates; bowls; cups; beverageware; beverage glassware; mugs; and canteens]</p> <p>Class 024. First use: First Use: 1998/04/00 First Use In Commerce: 1998/04/00</p> <p>[bed linens; bed sheets; pillow cases;pillow shams; comforters; bed spreads; quilts; bed blankets; jacquard throws, namely, throw blankets with a jacquard weave; window treatments, namely, swags and valances; curtains; draperies; fabric "door defenders" hanging cloth and fabric bannerettes, namely, cloth banners; beach towels; bath towels; hand towels; washcloths; kitchen towels; tea towels; oven mitts; potholders; textile place mats; and table cloths not of paper]</p> <p>Class 025. First use: First Use: 1995/02/10 First Use In Commerce: 1995/02/10</p> <p>clothing and footwear, namely, [baseball, painters and biking caps; long and]short sleeve T-shirts; [polo shirts; woven shirts; henley shirts, namely, collarless T-shirts with buttons; golf shirts; neckties; ties; nightgowns;] slippers; [athletic shoes; and canvas shoes, boots and sandals]</p> <p>Class 028. First use: First Use: 1997/07/00 First Use In Commerce: 1997/07/00</p> <p>toys, [games] and playthings, namely,[toy paper cut-out figures; toy city play sets of paper for demolition; blow-molded toy figures with an electronic sound mechanism; molded toy figures with articulated arms, legs and tail; plastic monster toys figures; play basics, namely, spring loaded jumping figures, eggs and miniature mountains containing toy figures, and vinyl sheets that inflate intocharacters upon impact; toy action hurling figures; toy action figures with sound or light functions; toy action figures that shoot missiles and/or water; metallic balloons, latex balloons; electronic toys, namely, electronic action figures, toy vehicles and toy walkie-talkies; molded toy figures with battery operatedelectromechanical motor with roaring sound; toy pick-up trucks with inflatableor inflated tires; articulated toy figures that emit orange-colored liquid; toyfoam heads mounted on soft plastic handles; toy walking figures driven by wind-up or battery operated motors; play kitsfor growing monster pods in water, comprised primarily of condensed plastic toyfigures that grow in water and vacuum-formed tray decorated with city scape; free-flowing play gel and toy dispensers sold therewith; toy candy dispensers; toypocket play arenas using free-flowing play gel cases; hobby craft sand art kits; sonic controlled toy monster trucks; foot bags used in a kicking action game; toy snap bracelets; playsets and accessories therefor, consisting primarily of toy figures, vehicles and neighborhoods; toy city play sets for demolition; toy action figure carry cases; wind-up/walking and friction driven toy figures; slidemanipulative puzzles; micro machine scale toy vehicles; toy banks; toy gum ballbanks; toy rotational molded figure banks with or without sound making moveablecapabilities with moveable parts; hobbycraft kits for making toy figures with air drying component; toy talking sculpted head; character toy figures with voice-emitting capabilities; stand alone computer output game machines and hand heldunits for playing electronic games;] plastic toy figures, [eggs, vehicles, playset cities and scenes for use therewith; mini-playface, namely, stuffed toy head that depicts character face; plastic,vinyl and soft sculpture toy figures; die cast miniature vehicles; plastic eggsconsisting of action figure toys; wind-up powered action toys; playground and rubber action balls; foam balls; basketballs; toy basketball hoop sets consistingprimarily of a basketball, basketball backboard and basketball hoop; basketballbackboards;</p>
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	party favors in the nature of small toys, namely, paper games, paper and plastic card games, model and toy cars, toy jewelry; toy party noisemakers, horns, whistles and rattles; dolls and puppets; inflatable swimming toys; latex squeeze toys; musical toys; skateboards; bath tub toys; children's multiple activity toys; and balloon paste used to make balloons or plastic bubbles]
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U.S. Registration No.	2134696	Application Date	10/13/1992
Registration Date	02/03/1998	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1996/06/01 First Use In Commerce: 1996/06/01 [paper party hats]</p> <p>Class 028. First use: First Use: 1993/12/00 First Use In Commerce: 1993/12/00 toys [and games,] namely, [battery-operated action toys; wind-up toys; manually-operated robot arm-like grabbing toys;] painted toy figures; [model kits for making toy monsters;] playsets with toy figures; [toy vehicles; toy weapons; plastic play and toy carry cases for children]; ((plush toys;))[manipulative puzzles; stuffed toys; mechanical action toys; and hobby craft kits of wood or plastic for assembling into toys]</p>		

U.S. Registration No.	4183291	Application Date	12/12/2011
Registration Date	07/31/2012	Foreign Priority Date	NONE
Word Mark	GODZILLA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 Prerecorded DVDs featuring motion pictures films</p> <p>Class 028. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Christmas tree ornaments; board games; card games</p>		

Attachments	75181532#TMSN.png(bytes) 85493317#TMSN.png(bytes) NoticeOfOpp_86494256.pdf(485253 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jill A. Jacobs/
Name	Jill A. Jacobs
Date	09/16/2015

4. Since 1956, Opposer has been engaged in the production and distribution of a series of motion pictures and other entertainment properties starring a fire-breathing monster character called “Godzilla” (the “Godzilla Character”), and the use, registration, and licensing of the GODZILLA trademark and related marks.

5. The GODZILLA word mark has been used in connection with a wide variety of goods and services. The GODZILLA mark and the Godzilla Character are famous in the United States and became famous long before the filing date of the Opposed Application, or any earlier date of actual use of the GODZILLA mark upon which Applicant can rely. Specifically, the Godzilla Character is one of the most widely-recognized fictional characters in the history of film and, during the last five ~~(5)~~ decades, the Godzilla Character has been the subject of ~~thirty~~ (30) motion picture films that have grossed many hundreds of millions of dollars worldwide and that have been viewed by many millions of Americans. The GODZILLA mark has been used in the title of 28 of the films. The most recent Godzilla film was released in 2014 and grossed \$200,000,000 in the United States.

6. Opposer owns United States Service Mark Registration No. 1,163,122 for the mark GODZILLA for entertainment services in the nature of a continuing motion picture film series; United States Trademark Registration No. 1,858,403 for the mark GODZILLA for cinematographic and motion picture films featuring entertainment; toys and games, namely, video and computer game programs; electronic game programs; vinyl toy figures; plastic inert figures; plastic action figures; United States Trademark Registration No. 1,161,858 for the mark GODZILLA for comic books; United States Trademark Registration No. 2,211,328 for the mark GODZILLA for comic books; clothing, namely, shirts; United States Trademark Registration No. 2,360,489 for the mark GODZILLA for clothing and footwear, namely, short sleeve T-shirts and slippers; toys and playthings, namely, plastic toy figures; United States Trademark Registration No. 2,134,696 for the mark GODZILLA for toys, namely, painted toy figures; playsets with toy figures; plush toys; and United States Trademark Registration No. 4,183,291 for the mark GODZILLA for prerecorded DVDs featuring motion picture films; Christmas tree ornaments; board games; card games. All of these registrations are valid and subsisting, and

Registrations Nos. 1,161,858; 1,163,122; 1,858,403; 2,211,328; and 2,134,696 have become incontestable. Copies of records of these registrations taken from the TSDR electronic database of the Patent and Trademark Office and showing the current status and title of these registrations are attached hereto as Exhibit 1. The GODZILLA mark and the Godzilla Character have been used in connection with a wide variety of other goods, including alcoholic and non-alcoholic beverages, coffee mugs, drinking glasses, cups, and food products.

7. Upon information and belief, Applicant was aware of Opposer's GODZILLA mark when Applicant selected the identical "GODZILLA" mark shown in the Opposed Application, and intended and intends to use the same in such a manner as to trade on the goodwill of the GODZILLA mark in the United States. Purchasers of Applicant's goods sold under Opposer's GODZILLA mark are likely to believe mistakenly that the goods originate with Opposer, or are licensed, sponsored, or authorized by Opposer.

FIRST CLAIM FOR RELIEF
(Likelihood of Confusion With Registered Trademarks)

8. Opposer repeats and realleges the allegations in preceding paragraphs 1-7, inclusive, as if fully set forth herein.

9. The mark shown in the Opposed Application so resembles Opposer's registered GODZILLA marks as to be likely, when used in connection with the goods identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d), as amended.

10. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration of the mark would give Applicant prima facie evidence of its ownership of, and exclusive right to use in commerce, a mark that is confusingly similar to Opposer's GODZILLA marks.

SECOND CLAIM FOR RELIEF
(Likelihood of Confusion With Previously-Used Marks)

11. Opposer repeats and realleges the allegations in preceding paragraphs 1-7, inclusive, as if fully set forth herein.

12. The mark shown in the Opposed Application so resembles Opposer's GODZILLA marks previously used in the United States and not abandoned as to be likely, when used in connection with the goods identified in the Opposed Application, to cause confusion, to cause mistake, and to deceive, and Applicant's mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d), as amended.

13. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration of the mark would give Applicant prima facie evidence of its ownership of, and exclusive right to use in commerce, a mark that is confusingly similar to Opposer's previously-used and not abandoned marks.

WHEREFORE, Opposer prays for the entry of judgment sustaining this opposition and refusing registration of the mark shown in the Opposed Application. Please charge the filing fees for this opposition to Deposit Account No. 50-2291 and direct all correspondence and communication in this opposition to the undersigned.

Respectfully submitted,

SEYFARTH SHAW LLP

Dated: September 16, 2015

By: 

Joan Kupersmith Larkin
Christopher C. Larkin
Jill A. Jacobs
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Los Angeles, California 90067-3021
Telephone: (310) 277-7200
Facsimile: (310) 201-5219

CERTIFICATE OF SERVICE

I hereby certify that on September 16, 2015, I served a copy of the foregoing Notice of Opposition on the applicant by depositing a true copy thereof in a sealed envelope, postage prepaid, in First-Class U.S. mail addressed to applicant's counsel at his address of record in the records of the Patent and Trademark Office as follows:

Michael I. Kroll, Esq.
80 Skyline Dr., Unit 304
Plainview, New York 11803-2516


Alexis Karriker

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Mark: GODZILLA

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for this case.

US Serial Number: 73217732

Application Filing Date: May 30, 1981

US Registration Number: 1161858

Registration Date: Jul. 21, 1981

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Apr. 22, 2011

Publication Date: Apr. 28, 1981

Mark Information**Goods and Services****Basis Information (Case Level)****Current Owner(s) Information****Attorney/Correspondence Information****Prosecution History****Maintenance Filings or Post Registration Information****TM Staff and Location Information****Assignment Abstract Of Title Information - Click to Load****Proceedings - Click to Load**

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Mark: GODZILLA

No Image exists
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US Serial Number: 73217718

Application Filing Date: May 30, 1981

US Registration Number: 1163122

Registration Date: Jul. 28, 1981

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Sep. 26, 2011

Publication Date: May 05, 1981

Mark Information**Goods and Services****Basis Information (Case Level)****Current Owner(s) Information****Attorney/Correspondence Information****Prosecution History****Maintenance Filings or Post Registration Information****TM Staff and Location Information****Assignment Abstract Of Title Information - Click to Load****Proceedings - Click to Load**

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Mark: GODZILLA

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US Serial Number: 74322225

Application Filing Date: Oct. 13, 1994

US Registration Number: 1858403

Registration Date: Oct. 18, 1994

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Apr. 18, 2015

Publication Date: Jul. 26, 1994

Mark Information**Related Properties Information****Goods and Services****Basis Information (Case Level)****Current Owner(s) Information****Attorney/Correspondence Information****Prosecution History****Maintenance Filings or Post Registration Information****TM Staff and Location Information****Assignment Abstract Of Title Information - Click to Load****Proceedings - Click to Load**

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Mark: GODZILLA

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US Serial Number: 74525545

Application Filing Date: May 17, 1995

US Registration Number: 2211328

Registration Date: Dec. 15, 1995

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Aug. 11, 2008

Publication Date: Jun. 06, 1995

Notice of Allowance Date: Aug. 29, 1995

Mark Information**Related Properties Information****Goods and Services****Basis Information (Case Level)****Current Owner(s) Information****Attorney/Correspondence Information****Prosecution History****Maintenance Filings or Post Registration Information****TM Staff and Location Information****Assignment Abstract Of Title Information - Click to Load****Proceedings - Click to Load**

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Mark: GODZILLA

No Image exists
for this case.

US Serial Number: 74322029

Application Filing Date: Oct. 13, 1994

US Registration Number: 2134696

Registration Date: Feb. 03, 1997

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Oct. 13, 2007

Publication Date: Aug. 23, 1994

Notice of Allowance Date: Nov. 15, 1994

Mark Information**Related Properties Information****Goods and Services****Basis Information (Case Level)****Current Owner(s) Information****Attorney/Correspondence Information****Prosecution History****Maintenance Filings or Post Registration Information****TM Staff and Location Information****Assignment Abstract Of Title Information - Click to Load****Proceedings - Click to Load**

